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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)  
32860-001044/US

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

Application Number  
10/580,687Filed  
May 26, 2006First Named Inventor  
Sebastian BUDZ

On \_\_\_\_\_

Art Unit  
2624Examiner  
Nancy Bitar

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor



Signature

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

For Donald J. Daley

Typed or printed name

attorney or agent of record.

Registration number 34,313.

(703)668-8000

Telephone number

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

March 9, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

\*Total of \_\_\_\_\_ forms are submitted.

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8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Sebastian BUDZ  
et al. Confirmation No.: 4363

Application No.: 10/580,687 Examiner: Nancy Bitar

Filing Date: May 26, 2006 Group Art Unit: 2624

Title: METHOD OF NAVIGATION IN THREE-DIMENSIONAL  
IMAGE DATA

Attorney Docket: 32860-001044/US

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Randolph Building  
401 Dulany Street  
Alexandria, VA 22314  
**Mail Stop AF**

March 9, 2010

**REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir/Madam:

In response to the Office Action dated December 9, 2009, Appellants request that an appointed panel of Examiners (hereinafter "the Panel") review the pending rejections.

**I. MATERIAL UNDER REVIEW**

Claims 1-19 are pending. Claims 1 and 16 are independent claims.

Claims 1-19 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Gering et al., *A System for Surgical Planning and Guidance using Image Fusion and Interventional MR*, hereinafter "Gering," in view of Golland et al., *Anatomy Browser: A Novel Approach to Visualization and Integration of Medical Information*, hereinafter "Golland."<sup>1</sup>

<sup>1</sup> Final Office Action, U.S. Appln. No. 10/580,687, U.S. Pat. and Trademark Office, p. 3 (December 9, 2009).

#### **A. INDEPENDENT CLAIMS 1 AND 16**

Claim 1 is directed to a method for navigating in three-dimensional electronic image data records. Relevant portions of claim 1 are provided below for the Panel's convenience.

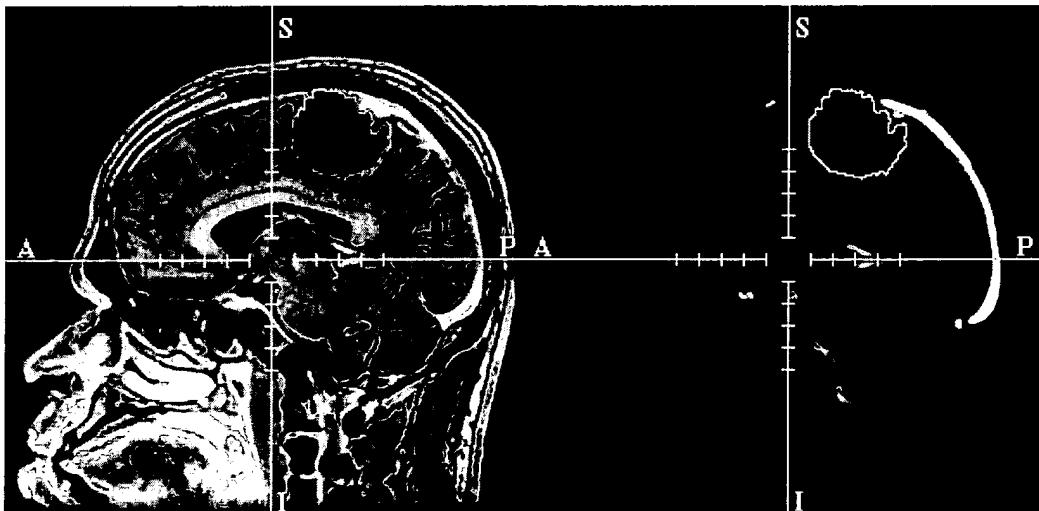
1. A method for navigating in three-dimensional electronic image data records, the image data records including three-dimensional partial image data records, the method comprising:

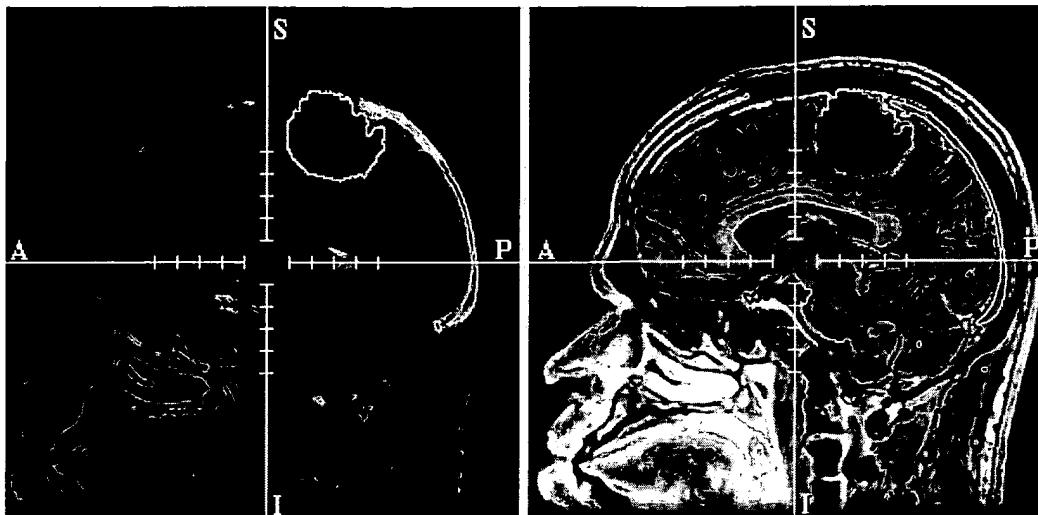
... automatically displacing, as a function of the user input, the at least one projection not including the at least one partial projection in such a way that it includes the partial projection.

Claim 16 is directed to an apparatus for navigating in three-dimensional electronic image data records and recites a similar feature. More specifically, claim 16 recites "a means for automatically displacing."

#### **B. THE GERING REFERENCE**

Gering discloses a surgical assistant using image fusion. Figure 2-5 of Gering, which is provided below for the Panel's convenience, describes blending techniques that are used.





An outline of a tumor segmentation is shown (in the S and P quadrant) in each of the four images of Figure 2-5. A user may click on a center of the tumor to magnify the tumor, as shown in Figure 2-7 below.



### C. THE GOLLAND REFERENCE

Golland discloses an anatomy browser which provides cross-referencing among types of displays. "If a user clicks on one of the display areas (<Shift-Click>), a cross-hair appears on all four displays at locations corresponding to the same 3D point." See, 4.2 of Golland. Thus, if an input is made for a first display, the other displays are not changed.

### II. A PRIMA FACIE CASE OF OBVIOUSNESS HAS NOT BEEN ESTABLISHED

The Examiner bears the initial burden of presenting a prima facie case of obviousness in rejecting claims under 35 U.S.C. § 103. See *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

Generally, each element of the claim must be known in the prior art for the claim to be obvious. See generally, *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 415-16, 82 USPQ2d 1385, 1395.

Claim 1 requires, *inter alia*, "automatically displacing ... the at least one projection not including the at least one partial projection in such a way that it includes the partial projection." (emphasis added). At least this feature is not disclosed or suggested by Gering, Golland or a combination of the two (assuming they could be properly combined, which Appellants do not admit).

On page 2 of the Office Action dated December 9, 2009, the Examiner relies on Gering to teach emphasized portion of claim 1 above. The Examiner clarified during the interview of February 23, 2010 that she is interpreting the "at least one projection not including the at least one partial projection" as the images having an outline of a tumor, as shown in Figure 2-5. Moreover, the Examiner provided that Gering discloses magnifying the tumor (Figure 2-7), thereby eliminating the majority of any one of the images shown in Figure 2-5. By magnifying the selected tumor, the Examiner believes that Gering teaches "automatically displacing, as a function of the user input, the at least one projection not including the at least one partial projection in such a way that it includes the partial projection."

However, claim 1 requires displacing a segmentation "not including the at least one partial projection in such a way that it includes the partial projection." Figure 2-5 illustrates an outline of a tumor. Moreover, Figure 2-7 illustrates a magnified version of the same tumor. Consequently, if the Examiner is interpreting the tumor as the partial projection, Figure 2-5 illustrates a projection with a partial projection. Thus, Figure 2-5 fails to illustrate a projection not including a partial projection. Therefore, the magnifying in Gering does not displace a projection not including a partial projection.

Even if Golland could be properly combined with Gering (which Appellants do not admit), Golland fails to cure the deficiencies of Gering as described above. Claims 2-15 are patentable at least by virtue of the dependence on claim 1.

Claim 16 is a separate independent claim from claim 1, wherein each independent claim contains its own individual limitations. Claim 16 should be interpreted solely based upon limitations set forth therein. However, claim 16 is patentable for at least reasons somewhat similar to those set forth above regarding claim 1. Claims 17-19, which are dependent on claim 16, are patentable for at least the reasons set forth above.

**CONCLUSION**

In view of the above remarks, Appellants respectfully request that the Panel withdraw the grounds of rejection and allow the pending claims.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Donald J. Daley at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. §1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By

  
Donald J. Daley, Reg. No. 34,313  
Blair M. Hoyt, Reg. No. 56,205

P.O. Box 8910  
Reston, Virginia 20195  
(703) 668-8000

DJD/BMH *Boink*



**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No.: 10/580,687

Filing Date: May 26, 2006

Applicant: Sebastian BUDZ et al.

Group Art Unit: 2624

Examiner: Nancy Bitar

Title: METHOD OF NAVIGATION IN THREE-DIMENSIONAL IMAGE DATA

Attorney Docket: 32860-001044/US

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Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

March 9, 2010

**Mail Stop AF**

**STATEMENT UNDER 37 C.F.R. § 1.133(b)**

Sir/Madam:

In response to the telephonic interview conducted on February 23, 2010 and the Interview Summary dated March 3, 2010, the following remarks are respectfully submitted in connection with the above-identified application.

**Interview Summary**

Applicants wish to thank the Examiner for her time during the telephonic interview of February 23, 2010. During the interview, Applicants and the Examiner discussed the merits of claim 1 relative to automatically displacing. During the interview, the Examiner asserted that Gering discloses the "automatically displacing." More specifically, the Examiner stated that she is interpreting the "at least one projection not including the at least one partial projection" as the images

having an outline of a tumor, as shown in Figure 2-5. Moreover, the Examiner provided that Gering discloses magnifying the tumor (Figure 2-7), thereby eliminating the majority of any one of the images shown in Figure 2-5. By magnifying the selected tumor, the Examiner believes that Gering teaches "automatically displacing, as a function of the user input, the at least one projection not including the at least one partial projection in such a way that it includes the partial projection."

Applicants and the Examiner did not reach an agreement. Consequently, Applicants have filed a Notice of Appeal with a Pre-Appeal Brief Request for Review.

**CONCLUSION**

Should there be any outstanding matters that need to be resolved in the present application; the Examiner is respectfully requested to contact the undersigned at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By

  
Donald J. Daley, Reg. No. 34,313  
Blair M. Hoyt, Reg. No. 56,205

P.O. Box 8910  
Reston, Virginia 20195  
(703) 668-8000

DJD/BMH/mas